

REMARKS

Summary of the Official Action and Reply

In the Official Action, claim 20 was allowed. Claims 11-18 were objected to as depending from a rejected base claim. Claims 1-10 and 19 were rejected under 35 U.S.C. 103(a).

By this Reply, Applicant has made no amends to the claims, and claims 1-20 are pending in the case.

Rejections Under 35 U.S.C. 103

Claims 1-10 and 19 stand rejected under 35 U.S.C. 103(a) as unpatentable over Huddleston et al. (US 5,653,472) in view of Mosher, Jr. (US 5,973,600). Applicant respectfully traverses these rejections.

With respect to independent claim 1, the references individually do not teach Applicant's invention, and there is no reason, suggestion, or motivation to combine these references to arrive at Applicant's invention.

Under 35 U.S.C. 103(a), there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by the Examiner. That knowledge cannot come from the Applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Further, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Thus, modification of Huddleston et al. in view of Mosher, Jr. in the suggested manner is improper, and is insufficient to present a *prima facie* case of obviousness.

Huddleston et al. teaches a form having a detachable wristband and labels. The brief specification of Huddleston et al. does not contain any reason, suggestion, or motivation to improve upon the Huddleston et al. form to include RFID capabilities within the wristband. In fact, Huddleston et al. teaches away from the use of circuitry within a wristband as "complex and difficult to implement." (Col. 1, lns. 26-35). This narrow thinking is reflected in the design of the Huddleston et al. wristband, which is formed from a single ply, the face ply, that is

removed from the form as a single ply during use. (Col. 3, lns. 50-58). There is no means to support a RFID tag or other circuitry within the Huddleston et al. design.

Likewise, Mosher, Jr. does not contain any reason, suggestion, or motivation to combine the references as proposed by the Examiner. Mosher, Jr. describes a wristband consisting of at least two laminae and, preferably, three laminae wherein an RF tag is incorporated into one or more of the laminae. (Col. 2, lns. 16-20). Clearly, the single ply wristband of Huddleston et al. and the multi-ply wristband of Mosher, Jr. are incompatible.

Furthermore, Mosher, Jr. contains absolutely no reason, suggestion, or motivation to incorporate labels onto the same form as the wristband. In fact, Mosher, Jr. describes a manufacturing process whereby multiple wristbands are made continuously from the same web of material by the utilization of scoring dies or the like. (Col. 4, lns. 17-20). This manufacturing process is contrary to a process that could result in the Applicant's invention as presented in claim 1.

For these reasons, Applicant's respectfully submit claim 1 is in a condition for allowance and request notice of the same. Claims 2-8 ultimately depend from claim 1, and necessarily include each of the elements of claim 1. Therefore, claims 2-8 are also in a condition for allowance.

Independent claim 9 also stands rejected under 35 U.S.C. 103(a) as unpatentable over Huddleston et al. in view of Mosher, Jr. This rejection is improper for at least two distinct reasons.

The first reason claim 9 is allowable is that there is no reason, suggestion, or motivation to combine the cited references. This has previously been discussed in detail with respect to claim 1, and applies with equal force here.

The second reason claim 9 is allowable is that the combination of the references, even if properly combined, fails to teach each and every element of the claim as required under 35 U.S.C. 103(a). Specifically, the combination of the cited references does not teach "a *first layer* having a detachable portion in the form of a wristband;" and, "a *second layer* bonded to the first layer by an adhesive, said *second layer* having labels die cut therefrom."

It can be appreciated that the wristband of claim 9 is part of the *first layer*, and the die cut labels are part of the *second layer*. The first layer, from which the wristband is formed, acts as a backing layer to the second layer, from which the labels are die cut.

Claim 9 claims a first layer having a wristband, and a second layer bonded to the first layer. Labels are die cut into the second layer. The first layer (wristband layer) extends beyond the wristband and underneath the second layer (die cut labels), where it acts as a backing material from which the die cut labels may be peeled.

Neither Huddleston et al. nor Moster Jr. teach or suggest at least these elements of claim 9. Moster, Jr. does not have any labels die-cut into any layer. Huddleston et al. does not make up for this deficiency, because the labels of Huddleston et al. are die cut into the first layer, or face ply. (Col. 3, lns. 37-63).

The elements of claim 9 not taught by the combination of Huddleston et al. and Moster, Jr. are not simply cosmetic. By making a first layer having a detachable wristband, and a second layer bonded to the first having die-cut labels, Applicant has effectively made the wristband layer the backing for the die-cut labels. This results in a significant savings of material. Furthermore, the wristband can be made thinner such that it will be printable in a laser printer or other commonly used computer driven printer.

Because the combination of Huddleston et al. and Moster Jr. fails to teach each and every element of claim 9, Applicant respectfully submits this claim is in a condition for allowance. Claims 10 and 19 depend from claim 9, and necessarily incorporate each of the elements of that claim. For this reason, claims 10 and 19 are also in a condition for allowance.

CONCLUSION

In view of these Amendments and Remarks, Applicant respectfully submits that each of the pending claims are patentable over the cited prior art, and are in a condition for allowance. Applicant respectfully requests that the Examiner withdraw the remaining objections to each of the pending claims. In the event that any matter in the present application could be addressed by Examiner's Amendment, the Examiner is urged to contact the undersigned attorney.

Respectfully submitted,

Dated: January 10, 2005

By:

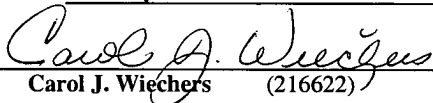


Nicholas Pruhs, Reg. No. 52,136
Wallenstein Wagner & Rockey, Ltd.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6630
312.554.3300

CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on January 10, 2005


Carol J. Wiechers (216622)